

REMARKS

Claims 1-32 are pending. Claims 13-32 are allowed. Claims 1, 3, 4, 6-9 and 12 are rejected. Claims 2, 5, 10 and 11 are objected to.

Claims 1 and 7-9 remain rejected under 35 U.S.C. 102(b) as being anticipated by Ueda (U.S. Patent No. 5,790,732). The Examiner alleges that Ueda teaches each and every element of the claimed invention. The Examiner alleges that, although it is argued that Ueda does not disclose a preliminary member which is cut with the fiber therein, the claim element to "produce, by cutting, a plurality of short capillary tubes with optical fibers" is a method limitation. The Examiner argues that method limitations are not given any patentable weight in product claims. Rather, product claims are simply examined with respect to product limitations. Thus, the method claim element has not been given any patentable weight, because a product rather than a method of making is claimed in claims 1 and 7-9.

Applicant respectfully traverses Examiner's anticipation rejection by amending claim 1. Applicant notes that this amendment provides for the insertion of fiber *before* cutting, thereby distinguishing the present invention from Ueda for at least this reason.

Applicant notes that the specification and drawings support that the claimed preliminary member is made up of a plurality of contiguous short capillary tubes with optical fibers, see Figure 1, and that the production or manufacture of a plurality of short capillary tubes actually refers to the cutting of the preliminary member so as to separate the short capillary tubes. See Figures 2 and 7; pages 11, 36 and 38 of the specification.

Applicant points out that since Ueda discloses the insertion of fiber after cutting the glass preform, as is acknowledged by the Examiner, the preform of Ueda cannot be characterized as being made up of a plurality of contiguous short capillary tubes with optical fibers as claimed.

Claim 3 remains rejected under 35 U.S.C. 103(a) as being obvious over Ueda. The Examiner alleges that it would have been obvious that the capillary member of Ueda would have a coefficient of linear expansion less than 7×10^{-6} /K, since it is known that fibers have a linear coefficient that is less than 7×10^{-6} /K.

Claims 4 and 6 remain rejected under 35 U.S.C. 103(a) as being obvious over Ueda. Regarding claim 4, the Examiner alleges that it would have been obvious that at least 50% of UV light would pass through the capillary member of Ueda in order to cure the adhesive, since the reference states that the fiber is adhered to the inside of the preliminary member using UV curable adhesive that passes through the coating of the member (col. 4, lines 40-45), and it is known that UV wavelengths range from 350-500 nm. With respect to claim 6, the Examiner alleges that it would have been obvious that at least 30% of light in the range of 700 nm-2500 nm would pass through the member of Ueda, because it is known that such a wide range of wavelengths would pass through due to the transparent properties of glass, and it is well known that preferred optical communication wavelengths fall within such a range.

Claim 12 also remains rejected under 35 U.S.C. 103(a) as being obvious over Ueda in view of Andersen (U.S. Patent No. 6,190,055). The Examiner alleges that it

would have been obvious to use the component disclosed by Ueda in an optical fixed attenuator as disclosed by Anderson. Andersen is cited for disclosing an optical device component as component for an optical fixed attenuator (col. 1, lines 5-15). The Examiner notes that is well known that optical fibers have a constant attenuation factor. See page 5 of the Office Action.

Applicant respectfully traverses Examiner's rejections of claims 3, 4, 6, and 12. As discussed above, the primary reference of each of these rejections, Ueda, fails to teach or suggest any "preliminary member made up of a plurality of contiguous short capillary tubes with optical fibers". Moreover, the secondary reference Anderson is unable to cure this deficiency of Ueda. Accordingly, with the amendment of claim 1 set forth above, no combination of the cited references is able to teach or suggest each and every element of the claimed invention.


Claims 2, 5, 10 and 11 are objected to as being dependent upon rejected base claim 1. Applicant respectfully traverses Examiner's objection. Applicant notes that this objection is addressed through the proposed amendment of claim 1 discussed above.

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of all pending claims 1-32, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing docket number 100725-00046.

Respectfully submitted,
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